

REMARKS

Applicants acknowledge receipt of the Final Office Action mailed August 6, 2008.

In the Final Office Action, the Examiner rejected claims 75 and 90-101 under 35 U.S.C. § 102(b) as being anticipated by *Richards et al.* (U.S. Patent No. 6,296,809); and rejected claims 102-113 under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Ammann et al.* (U.S. Patent Pub. No. 2005/0233370).

By this Amendment, Applicants propose to amend claims 75 and 102, cancel claims 1-47, without prejudice or disclaimer, and add new claims 114-121. Claims 75, and 90-115 remain pending. Of these claims, claims 75, 102, and 118 are independent.

Applicants traverse the rejections above and respectfully request reconsideration for at least the reasons that follow.

I. 35 U.S.C. § 102(b) REJECTION

Applicants traverse the rejection of claims 75 and 90-101 under 35 U.S.C. § 102(b) as being anticipated by *Richards*. However, in an effort to expedite prosecution, Applicants have amended claim 75 and respectfully submit that independent claim 75 distinguishes over *Richards* at least for the reasons described below.

In order to properly establish that *Richards* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Richards appears to disclose an apparatus and method for automatically staining or treating multiple tissue samples mounted on microscope slides. Individualized slide temperature control is accomplished by a heating system 48, which includes thermal platforms radially mounted to a carousel for heating the slides and sensing the temperature of each. (*Richards*, Abstract).

Richards, however, does not disclose an automated sample processing system “wherein [a] carrier may be inserted or removed during [a] processing protocol without interrupting a processing of another sample,” as required by amended claim 75.

Since *Richards* fails to disclose each and every element of independent claim 75, *Richards* fails to anticipate claim 75, and claims 90-101, that depend from claim 75. Therefore, Applicants respectfully request that this rejection be withdrawn.

II. 35 U.S.C. § 103(a) REJECTION

Claims 102-113 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Richards* in view of *Ammann*. Applicants respectfully disagree with the Examiner’s arguments and conclusions and submit that independent claim 102 distinguishes over *Richards* and *Ammann* at least for the reasons previously described. However, in an effort to expedite prosecution, claim 102 has been amended and Applicants respectfully submit that *Richards* and *Ammann* do not teach or suggest claim 102 as currently amended.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *Id.* “[T]he

framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

As discussed above, *Richards* appears to disclose an apparatus and method for automatically staining or treating multiple tissue samples mounted on microscope slides. Individualized slide temperature control is accomplished by a heating system 48, which includes thermal platforms radially mounted to a carousel, for heating the slides and sensing the temperature of each. (*Richards*, Abstract).

As admitted by the Examiner, “Richards...does not expressly disclose that reagent temperature control elements are provided for regulating the temperature of reagents before they are applied to the sample.” (*Final Office Action*, p. 4, para. 2). Furthermore, as reiterated above, *Richards* also fails to disclose or suggest “wherein [a] carrier may be inserted or removed during [a] processing protocol without interrupting a processing of another sample,” as recited in amended claim 102.

In order to cure the deficiencies of *Richards*, the Examiner relies on *Ammann* and alleges “Ammann teaches that thermoelectric modules and fan units provide the desired cooling capacity, and are capable of regulating the temperature of a plurality of reagents maintained in a plurality of containers.” (*Final Office Action*, pp. 4-5, para. 2). Such teaching, even if disclosed in *Ammann*, which Applicants do not necessarily

concede, fails to teach or suggest, “wherein [a] carrier may be inserted or removed during [a] processing protocol without interrupting a processing of another sample,” as recited in independent claim 102. Thus, *Ammann* also fails to overcome the above noted shortcomings of *Richards*.

In fact, *Ammann* teaches away from the claimed limitation recited in amended claim 102. *Ammann* discloses that

[a] plurality of reaction receptacles are loaded in a stacked fashion in the input queue 150. . . . A reaction receptacle shuttle assembly . . . within the queue moves the receptacles along a receptacle advance path toward the pick-up position. . . . The queue includes a drawer which may be pulled out for loading the receptacles therein. Before the drawer is opened, however, it must be unlocked and the shuttle must disengage from the receptacle advance path. When the drawer is again closed, it is locked and the shuttle engages the receptacles and moves them toward the pick-up position. (*Ammann*, paras. [0106] - [0107]).

Accordingly, a processing of a reaction receptacle is interrupted when additional reaction receptacles are inserted during a processing protocol, as the drawer which loads the receptacles therein must be unlocked and the reaction receptacle shuttle assembly must disengage from the receptacle advance path before additional reaction receptacles are added.

As explained above, the elements of amended independent claim 102 are neither taught nor suggested by the cited references and no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 102, and claims 103-113, which depend from claim 102. Claims

102-113 are therefore patentable over *Richards* and *Ammann* and Applicants request that the rejection of claims 102-113 under 35 U.S.C. § 103(a) be withdrawn.

III. NEW CLAIMS

New claims 114-117 correspondingly depend from claims 75 and 102 and are allowable at least for the same reasons as claims 75 and 102. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the cited art.

New independent claim 118, and corresponding dependent claims 119-212, are allowable for at least the same reasons as independent claims 75 and 102. The cited prior art references fail to teach or suggest, *inter alia*, “wherein the carrier and the reagent may be inserted or removed during the processing protocol without interrupting a processing of another sample.”

IV. CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 75 and 90-121 in condition for allowance.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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